

REMARKS

This application has been carefully reviewed in light of the Office Action dated August 16, 2005. Claims 1 to 18, 22 to 55, 57 and 58 are in the application, of which Claims 1, 54, 55, 57 and 58 are all independent. Reconsideration and further examination are respectfully requested.

Claim 54 was rejected under 35 U.S.C. § 112, second paragraph, for insufficient antecedence for the claimed "first interface". In response, Claim 54 has been amended so as to supply the needed antecedence. Withdrawal of the rejection is therefore respectfully requested.

Claims 55 and 57 were rejected under 35 U.S.C. § 112, second paragraph, it being said that "a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite". Applicants respectfully reject the characterization of Claims 55 and 57 as "both an apparatus and method steps of using the apparatus", since these claims are very clearly delimited to a network computing device (for Claim 55) or a computer-readable medium (for Claim 57). The clear language of the claims does not permit a reading of a claim that claims "both an apparatus and method steps of using the apparatus", but rather the language very clearly specifies apparatuses alone. For example, the network computing device of Claim 55 specifies a program memory for storing process steps "executable" to perform a method according to any of its dependent claims. No method is therefore being claimed, since the process steps stored in the program memory are "executable" and not necessarily "executed".

Moreover, as recently explained by the USPTO in its "Interim Guidelines for Examination of Patent Applications for Subject Matter Eligibility" (published at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf), it is wrong to state that an apparatus claim even with process steps is somehow a "hybrid":

"Note that an apparatus claim with process steps is not classified as a 'hybrid' claim; instead, it is simply an apparatus claim including functional limitations. See, e.g., *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished)." (Interim Guidelines at page 15).

Nevertheless, in an effort to advance prosecution of this case, each of Claims 55 and 57 have been rewritten so that they do not include references to any other claims. Withdrawal of the § 112 rejection is therefore respectfully requested.

Claims 55 and 57 were further rejected under 35 U.S.C. § 101, it being said that the claims were directed to neither a "process" nor a "machine", but rather embrace or overlap two different statutory classes of invention. The rejection is respectfully traversed, since it is founded on a faulty legal predicate, and since it is technologically inaccurate.

The rejection is founded on a faulty legal predicate because it attempts to categorize the claims into one category of the four § 101 categories. There simply is no requirement that a claim fall into a single category. Rather, the proper test for compliance with § 101 is whether the claim falls within "at least one" category. The aforementioned Interim Guidelines put it this way:

"To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. § 101, USPTO personnel must first identify whether the claim falls within at least one of the

four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

“In many instances it is clear within which of the enumerated categories a claimed invention falls. Even if the characterization of the claimed invention is not clear, this is usually not an issue that will preclude making an accurate and correct assessment with respect to the section 101 analysis. The scope of 35 U.S.C. § 101 is the same regardless of the form or category of invention in which a particular claim is drafted. [citation omitted]. See also *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602 wherein the Federal Circuit explained:

‘The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter -- [provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristics of the subject matter, in particular, its practical utility.’

“For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter it belongs in, does not affect the analysis to be performed by the examiner.” (Interim Guidelines at pages 14 to 15).

Accordingly, it is legal error to reject a claim for the reason that it might embrace or overlap two different statutory classes, since the only requirement is that the claims embrace “at least one”.

As for the technological basis, the language of the claims is clear that they are directed to a network computing device (in the case of Claim 55) or a computer-readable medium (in the case of Claim 57). Neither claim specifies that the process steps are actually executed (although an infringing device might ordinarily include execution of the process steps), but rather merely state that the process steps are “executable”. Accordingly, it is

wrong from a technological perspective to state that the claims are directed to both a process and to a machine.

Nevertheless, as indicated above, Claims 55 and 57 have been rewritten so as to avoid reference to any other claim. Withdrawal of the rejection is therefore respectfully requested.

Claims 1 to 18 and 22 to 54 were rejected under 35 U.S.C. § 101, it being said that they are directed to method steps which can be practiced mentally in conjunction with pen and paper. The rejection is respectfully traversed, since it is based on a line of reasoning that has been clearly repudiated by the Patent Office. Specifically, Annex III to the aforementioned Interim Guidelines includes the following:

"As set forth in the patent eligible subject matter interim guidelines, a practical application of a 35 U.S.C. § 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result. Therefore the following tests are not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter:

- (A) "not in the technological arts" test
- (B) Freeman-Walter-Abele test
- (C) mental step or human step tests
- (D) the machine implemented test
- (E) the per se data transformation test."

(Interim Guidelines at page 42, emphasis in original.)

Thus, the § 101 rejection of Claims 1 to 18 and 22 to 54 is faulty since it relies on the repudiated "mental step" test. Nevertheless, it was not Applicants' intention to claim a method practiced mentally in conjunction with pen and paper. Accordingly, and as

suggested by the Examiner, Claims 1 and 54 have been amended so as to specify a "computer-implemented" method.

Claims 55 and 57 were objected to under 37.C.F.R. § 1.75(c) as being of improper dependent form. According to the Office Action (at page 5), the claims are improper dependent claims because they do not particularly point out and distinctly claim subject matter of the invention. The objection is respectfully traversed, since there is absolutely no unclarity in these claims. As explained above, they are respectively directed to a network computing device (Claim 55) or a computer-readable medium (Claim 57) that includes computer-executable process steps that are not necessarily executed but which might be. As such, the claims indeed "particularly point out and distinctly claim the subject matter of the invention", and the objection should be withdrawn.

Nevertheless, and as indicated above, in an effort to advance prosecution, Claims 55 and 57 have been rewritten so that they do not refer to another claim. Withdrawal of the objection is respectfully requested.

No other matters being raised in the office Action, it is believed that the entire application is fully in condition for allowance, and such action is courtcously solicited.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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